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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,075	11/06/2001	Johann Engelhardt	5005-1009	4876

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EXAMINER

FINEMAN, LEE A

ART UNIT PAPER NUMBER

2872

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,075

Applicant(s)

ENGELHARDT ET AL.

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. A formal drawing page was received on 17 January 2003. Although a corrected drawing sheet with the changes mark in red was not received, the examiner has provided these changes on a copy in the file so as to properly record and approve them and therefore, these drawings are acceptable.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellmuth et al., U.S. Patent No. 5,795,295 in view of Kempe, U.S. Patent No. 6,151,127.

Hellmuth et al. discloses in fig. 1 an arrangement for visual and quantitative three-dimensional examination of specimens comprising a stereomicroscope (100, column 4, lines 65-67) with an objective (110) and a first and second eyepiece (180) wherein the objective and eyepieces define a first and a second beam path (fig. 1) and a scanning device (420) connected to the stereomicroscope thereby providing a scanning beam path (430) wherein the scanning device scans a specimen (1000) through the objective and acquires data for a three dimensional visual depiction of the specimen, wherein the stereomicroscope is equipped with a camera port (in so far as an imaging device is attached) at which the scanning device couples the scanning beam

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into the stereomicroscope, and wherein the scanning device is connected to a computer (500) that analyses the image data acquired and displays them on a display (210). Hellmuth et al. discloses the claimed invention except for the scanning device being a confocal scanning device and a further lens being provided before the objective to guide the scanning beam path parallel to observation beam paths. Relay lenses are well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to insert a relay lens between the mirror (120) and the objective to allow for longer focal distances within the stereomicroscope. Kempe teaches a confocal scanning device for examining biological tissue (fig. 1) with a computer (44) and display (46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the scanning device of Hellmuth et al. with the confocal scanning device of Kempe to provide better image resolution and contrast discrimination.

3. Claims 2, 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellmuth et al. in view of Kempe, as applied to claims 1 and 8 above, and further in view of Kitagawa et al., U.S. Patent No. 6,297,904 B1.

Hellmuth et al. in view of Kempe, as applied to claims 1 and 8 above, discloses the claimed invention except wherein the confocal scanning device is mounted on the stereomicroscope so that the scanning beam is coupled into the path of at least one of the observation beam paths with an optical coupling-in element. Kitagawa et al. teaches a confocal microscope (fig. 3) wherein the confocal scanning device (20) is mounted on the stereomicroscope so that the scanning beam is coupled into the observation beam path (column

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6, lines 4-19) with an optical coupling-in element (30). It would have been obvious to one of ordinary skill in the art at the time the invention was made use the optical coupling-in element of Kitagawa et al. with the system of Hellmuth et al. in view of Kempe to macroscopically observe the confocal images of the specimen (Kitagawa et al., column 6, lines 17-19).

Response to Arguments

4. Applicant's arguments filed 17 January 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge that confocal scanning provides better image resolution and contrast discrimination is generally available to one of ordinary skill in the art.

The applicant further argues that connecting the confocal scanning device of Kempe with the surgical microscope of Hellmuth et al. would not provide a working device, as the scanning device disposed in the illumination and detection path would interfere with three dimensional viewing of the specimen. The examiner disagrees. In fig. 1, the scanner (420) and illumination (310) of Hellmuth et al. do not interfere with the viewing of the specimen because of the

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beamsplitter (120). Therefore the scanner and illumination of Kempe would not interfere with the viewing of the specimen, as it too would be directed by the beamsplitter.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF

March 11, 2003


MARK A. ROBINSON
PRIMARY EXAMINER